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26875 7590 10/01/2009 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
EXAMINER				
EWALD, MARIA VERONICA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,352

Applicant(s)

SCHARNINGHAUSEN ET AL.

Examiner

MARIA VERONICA D. EWALD

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 8-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-19, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 and 23 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

13. Claims 23 – 24 are objected to because of the following informalities: Applicant argues in their response that claims 23 and 24 depend on claims 1 and 13, respectively; however, as written, both claims depend on claim 11. Appropriate correction is required.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 3, 5, 8 – 10, 12 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenstone, et al. (U.S. 2,101,755) in view of VolkI (U.S. 6,390,799). Rosenstone, et al. teach a portioning device for portioning a bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (figure 1) for forming the mass, the forming space (figure 1; column 1, lines 30 – 40) having first and second sections, the wall including a slit between the first and second sections of the forming space (figure 1) and an output opening (figure 1); the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a

plurality of mass portions (item 16 – figure 1), the cutting device having a cutter that is at least partially introducible through the slit (figure 1) into the forming space, and each of the plurality of mass portions being output as an end product from the forming space through the output opening; wherein the slit extends far enough through the wall so that the cutter can cut completely through a cross section of the forming space (figure 1); wherein the cutting device is introducible into the forming space in a direction that lies approximately perpendicular to the direction in which the mass is filled into the forming space (figure 1); wherein the forming space has a filling opening through which the mass can be filled into the forming space (column 2, lines 28 – 30); wherein the forming space has a geometry matched to the form of the end product (figure 1); wherein the forming space is defined inside a tube (item 7 – figure 1) through which the mass is axially transportable (figure 1).

The reference also teaches that the cutter is introducible into the forming space at a place such that each of the plurality of mass portions formed, when the cutter is introduced, is supported by at least part of the wall (figure 1); wherein the slit is spaced apart at a distance from an output opening of the forming space such that a section of the forming space corresponds at least approximately to the size of each of the plurality of mass portions (figure 1); wherein the wall is substantially cylindrical and the slit almost completely penetrates the wall (figure 1); wherein there are means for fastening the cutting device as an attachment to a device for transporting and/or mincing bulk material (figure 1; column 1, 40 – 55; column 2, lines 1 – 20); wherein the geometry has a cross section that is substantially rotationally symmetrical (figures 1 and 2).

Rosenstone, et al., however do not teach that the wall has a unitary construction; however, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Furthermore, Rosenstone, et al. may not teach that the shape of the forming space is oval; however, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

In addition, Rosenstone, et al. do not teach that the cutting device has a motor coupled with the cutter of the cutting device, the motor configured to spin the cutter about an axis of rotation so that at least a portion of the cutter rotates during each full rotation about the axis of rotation from a location outside of the wall through the slit into

the forming space, across the forming space and through the slit out of the forming space to a location outside of the wall. This, however, is merely automating a manual activity and would have been obvious to one of ordinary skill in the art. Per MPEP 2144.04, it has been held that broadly providing an automatic or mechanical means to replace a manual activity which *accomplishes the same result* is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) Thus, the Examiner contends that attaching a motor to the cutter, such that the cutter is automated in its cutting abilities through the slit and out of the forming space is well within the level of one of ordinary skill in the art. For example, in an apparatus to cut foodstuffs, Volkl teaches a forming space or shaping tube (item 53 – figure 3) through which foodstuffs are extruded vertically. A rectangular cutter (item 65 – figure 2) is attached to cutting cylinders which control the movement of the cutter back and forth across a slit through the forming space (column 4, lines 25 – 30 and 60 – 65). Alternatively, the cutter may be modified as a rotating cutting device or exchangeable blades. If a disk-cutter is used, a motor spins the cutter along a circle or part of a circle along an axis of rotation outside the cutting hole and through the slit. Thus, a continuous rotary movement is possible (column 4, lines 50 – 60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify or configure the apparatus of Rosenstone, et al. such that the cutter is coupled to a motor such that the cutter spins about an axis of rotation outside of the forming space as taught by Volkl, through the forming space and

through the slit to a location outside of the wall for the purpose of automating and making continuous the cutting capability of the apparatus of Rosenstone, et al.

Claims 13, 15 and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenstone, et al. in view of Volkl. Rosenstone, et al. teach a device for transporting and/or mincing bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (see figure 1 above) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1); the forming space having a geometry matched to the form of an end product, the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (item 16 – figure 1), the cutting device having a cutter that can be introduced through the slit at least partially into the forming space, and each of the plurality of mass portions being output as the end product from the forming space through the output opening (figure 1); wherein the slit extends far enough through the wall so that the cutter can cut completely through the cross section of the forming space (figure 1); wherein the device is further comprised of means for transporting the mass, the means of transport being discontinuously operable, and the timing of the discontinuous operation cooperating with the introductory motion of the cutter into the forming space for portioning the mass into the plurality of mass portions (column 2, lines

25 – 32); wherein the geometry has a cross-section that is substantially rotationally symmetrical (figure 1).

Rosenstone, et al., however, do not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Furthermore, though Rosenstone, et al. may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

The Examiner is noting that Applicant has claimed in claim 15 a "means for transporting the mass, which is discontinuously operable." The Examiner is interpreting such a limitation as an invocation of 35 U.S.C. 112, 6th paragraph and as such, such means are identified as a rotary vane pump or double screw pump which can be discontinuously operated and the equivalents thereof of such elements. Because Rosenstone, et al. teach a screw and spring assembly, which is manually operated and can be discontinuously operated to transport and press the bulk material to the outlet opening, the Examiner identifies the components of Rosenstone, et al. as meeting the limitations of claim 15.

The Examiner also notes that Rosenstone, et al. do not teach that the cutting device has a motor coupled with the cutter of the cutting device, the motor configured to spin the cutter about an axis of rotation so that at least a portion of the cutter rotates during each full rotation about the axis of rotation from a location outside of the wall through the slit into the forming space, across the forming space and through the slit out of the forming space to a location outside of the wall. This, however, is merely automating a manual activity and would have been obvious to one of ordinary skill in the art. Per MPEP 2144.04, it has been held that broadly providing an automatic or mechanical means to replace a manual activity which *accomplishes the same result* is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) Thus, the Examiner contends that attaching a motor to the cutter, such that the cutter is automated in its cutting abilities through the slit and out of the forming space is well within the level of one of ordinary skill in the art. For

example, in an apparatus to cut foodstuffs, Volkl teaches a forming space or shaping tube (item 53 – figure 3) through which foodstuffs are extruded vertically. A rectangular cutter (item 65 – figure 2) is attached to cutting cylinders which control the movement of the cutter back and forth across a slit through the forming space (column 4, lines 25 – 30 and 60 – 65). Alternatively, the cutter may be modified as a rotating cutting device or exchangeable blades. If a disk-cutter is used, a motor spins the cutter along a circle or part of a circle along an axis of rotation outside the cutting hole and through the slit. Thus, a continuous rotary movement is possible (column 4, lines 50 – 60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify or configure the apparatus of Rosenstone, et al. such that the cutter is coupled to a motor such that the cutter spins about an axis of rotation outside of the forming space as taught by Volkl, through the forming space and through the slit to a location outside of the wall for the purpose of automating and making continuous the cutting capability of the apparatus of Rosenstone, et al.

Claims 1 – 3, 5, 8 – 12, 16 – 17 and 23 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman (U.S. 2,500,973) in view of Volkl. Ackerman teach a portioning device for portioning a bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space (figure 1) bounded by a wall (figure 1) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1); the second section disposed between the slit

and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (items 22 and 24 – figures 6 and 7), the cutting device having a cutter that is at least partially introducible through the slit (figures 1, 6 and 7) into the forming space, and each of the plurality of mass portions being output as an end product from the forming space through the output opening; wherein the slit extends far enough through the wall so that the cutter can cut completely through a cross section of the forming space (figure 1); wherein the cutting device is introducible into the forming space in a direction that lies approximately perpendicular to the direction in which the mass is filled into the forming space (figure 1); wherein the forming space has a filling opening through which the mass can be filled into the forming space (figure 1); wherein the forming space has a geometry matched to the form of the end product (figure 1); wherein the forming space is defined inside a tube (item 10 – figure 1) through which the mass is axially transportable (figure 1).

Furthermore, the reference also teaches that the cutter is introducible into the forming space at a place such that each of the plurality of mass portions formed, when the cutter is introduced, is supported by at least part of the wall (figure 1); wherein the slit is spaced apart at a distance from an output opening of the forming space such that a section of the forming space corresponds at least approximately to the size of each of the plurality of mass portions (figure 1); wherein the wall is substantially cylindrical and the slit almost completely penetrates the wall (figure 1); wherein the cutter is a two-bladed, rotatable cutting knife (items 22 and 24 – figures 4 and 5; column 3, lines 20 – 65); wherein there are means for fastening the cutting device as an attachment to a

device for transporting and/or mincing bulk material (figure 1; column 3, lines 1 – 30); wherein the geometry has a cross section that is substantially rotationally symmetrical (figures 1 and 4 – 5).

Ackerman, however, does not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Furthermore, though Ackerman may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

In addition, Ackerman do not teach that the cutting device has a motor coupled with the cutter of the cutting device, the motor configured to spin the cutter about an axis of rotation so that at least a portion of the cutter rotates during each full rotation about the axis of rotation from a location outside of the wall through the slit into the forming space, across the forming space and through the slit out of the forming space to a location outside of the wall. This, however, is merely automating a manual activity and would have been obvious to one of ordinary skill in the art. Per MPEP 2144.04, it has been held that broadly providing an automatic or mechanical means to replace a manual activity which *accomplishes the same result* is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, the Examiner contends that attaching a motor to the cutter, such that the cutter is automated in its cutting abilities through the slit and out of the forming space is well within the level of one of ordinary skill in the art. For example, in an apparatus to cut foodstuffs, Volkl teaches a forming space or shaping tube (item 53 – figure 3) through which foodstuffs are extruded vertically. A rectangular cutter (item 65 – figure 2) is attached to cutting cylinders which control the movement of the cutter back and forth across a slit through the forming space (column 4, lines 25 – 30 and 60 – 65). Alternatively, the cutter may be modified as a rotating cutting device or exchangeable blades. If a disk-cutter is used, a motor spins the cutter along a circle or part of a circle along an axis of rotation outside the cutting hole and through the slit. Thus, a continuous rotary movement is possible (column 4, lines 50 – 60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify or configure the apparatus of Ackerman such that the cutter is coupled to a motor such that the cutter spins about an axis of rotation outside of the forming space as taught by Volkl, through the forming space and through the slit to a location outside of the wall for the purpose of automating and making continuous the cutting capability of the apparatus of Ackerman.

Claims 13, 15 and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman in view of Volkl. Ackerman teaches a device for transporting and/or mincing bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (figure 1) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1), the forming space having a geometry matched to the form of an end product, the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (item 22 and 24 – figures 1 and 4 – 5), the cutting device having a cutter that can be introduced through the slit at least partially into the forming space, and each of the plurality of mass portions being output as the end product from the forming space through the output opening (figure 1); wherein the slit extends far enough through the wall so that the cutter can cut completely through the cross section of the forming space

(figure 1); wherein the geometry has a cross-section that is substantially rotationally symmetrical (figure 1).

Ackerman, however, does not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Furthermore, though Ackerman may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

The Examiner is noting that Applicant has claimed in claim 15 a "means for transporting the mass, which is discontinuously operable." The Examiner is interpreting such a limitation as an invocation of 35 U.S.C. 112, 6th paragraph and as such, such means are identified as a rotary vane pump or double screw pump and the equivalents thereof of such elements which can be discontinuously operated. Because Ackerman teaches a screw and spring assembly, which is manually operated and can be discontinuously operated to transport and press the bulk material to the outlet opening, the Examiner identifies the components of Ackerman as meeting the limitations of claim 15.

In addition, Ackerman do not teach that the cutting device has a motor coupled with the cutter of the cutting device, the motor configured to spin the cutter about an axis of rotation so that at least a portion of the cutter rotates during each full rotation about the axis of rotation from a location outside of the wall through the slit into the forming space, across the forming space and through the slit out of the forming space to a location outside of the wall. This, however, is merely automating a manual activity and would have been obvious to one of ordinary skill in the art. Per MPEP 2144.04, it has been held that broadly providing an automatic or mechanical means to replace a manual activity which *accomplishes the same result* is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, the Examiner contends that attaching a motor to the cutter, such that the cutter is automated in its cutting abilities through the slit and out of the forming space is well within the level of one of ordinary skill in the art. For example, in an apparatus to cut

foodstuffs, Volkl teaches a forming space or shaping tube (item 53 – figure 3) through which foodstuffs are extruded vertically. A rectangular cutter (item 65 – figure 2) is attached to cutting cylinders which control the movement of the cutter back and forth across a slit through the forming space (column 4, lines 25 – 30 and 60 – 65). Alternatively, the cutter may be modified as a rotating cutting device or exchangeable blades. If a disk-cutter is used, a motor spins the cutter along a circle or part of a circle along an axis of rotation outside the cutting hole and through the slit. Thus, a continuous rotary movement is possible (column 4, lines 50 – 60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify or configure the apparatus of Ackerman such that the cutter is coupled to a motor such that the cutter spins about an axis of rotation outside of the forming space as taught by Volkl, through the forming space and through the slit to a location outside of the wall for the purpose of automating and making continuous the cutting capability of the apparatus of Ackerman.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Rosenstone, et al. or Ackerman in view of Volkl and further in view of Abler (U.S. 5,230,267). Rosenstone, et al., Ackerman and Volkl teach the characteristics previously described but do not specifically teach that there is a smoothing belt and a shaping surface.

In a method to form and subsequently process meat or other food slices, Abler teaches the use of a smoothing belt used in conjunction with a conveyor (items 15 and

16 – figure 1). The smoothing belt functions to uncurl or ensure that the slices remain flat as they are transported on the conveyor.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to configure the apparatus of either Rosenstone, et al. or Ackerman with the automated cutter of Volkl further configured with a conveyor belt and smoothing surface as taught by Abler, for the purpose of conveying the meat patties to its final processing station, while at the same time, ensuring that the surface of the patties retain their flat shape or final shape.

Allowable Subject Matter

15. Claims 21 – 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art references of Rosenstone, et al. and Ackerman fail to teach or suggest, either alone or in combination, that the second section of the forming space has a slightly larger diameter than the first section.

Response to Arguments

16. Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive. Applicant's primary argument with independent claims 1 and 13 and the rejection of such claims as obvious over the previously-cited references of Rosenstone, et al. and Ackerman is that one of ordinary skill in the art would not modify either

apparatus with a motor and a spinning cutter as claimed because each apparatus includes some feature which would render the modification or combination inoperable. The Examiner disagrees. Though Applicant has amended claims 1 and 13 to include the feature of an automated cutter, which is coupled to a motor such that the cutter spins about an axis of rotation from outside the forming space, across the forming space and to a location outside of the wall, the Examiner still contends that one of ordinary skill in the art would combine the references of either Rosenstone, et al. or Ackerman with the reference of Volkl to produce an apparatus wherein the foodstuffs are no longer manually severed, but continuously severed via an automated process. The results achieved through such a modification are merely to cut the foodstuffs, and thereby cut them quickly and produce a larger volume.

The evolution in food processing is and has been to make things quicker and produce larger quantities of food in a shorter amount of time, such that minimal effort is expended by the operator or user and thus, the Examiner contends that one of ordinary skill in the art would have the common sense to combine the automated apparatus of Volkl with that of either Rosenstone, et al. or Ackerman to produce the cut foodstuffs in larger volumes and in a shorter amount of time.

The Examiner also contends that the combination of references is proper regardless of whether there are features on the apparatus of Rosenstone, et al. or Ackerman which Applicant argues may impede the inclusion of a motor coupled to a rotating cutter. The apparatus of Rosenstone, et al. and Ackerman are manual shaping and cutting devices, wherein the apparatus of Volkl, is also a shaping and cutting device

but is merely an automated device which makes the process simpler for the user. All three apparatus achieve the same results. Per MPEP 2145, "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and In re Nievelt, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures.")

Applicant also argues that it would not have been obvious to fabricate the shaping tube of Ackerman as a unitary tube. The Examiner disagrees. Even though Ackerman's apparatus is in multiple parts to provide for disassembly and cleaning, one of ordinary skill in the art would be fully capable of fabricating a one-piece shaping tube such that the cutter can be assembled with the tube and removed easily.

The Examiner also maintains the rejection of claim 14 and also rejects new claims 23 and 24, but notes that both claims depend on claim 11 not on claim 1 and 13, respectively, as argued by Applicant.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARIA VERONICA D. EWALD** whose telephone number is (571)272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVE

/Maria Veronica D Ewald/
Primary Examiner, Art Unit 1791